

AF 1771/S
1764

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stephen Robert Carkeek
Serial No.: 09/486,629
Filed : March 1, 2000
For : TABLE OR COUNTER MAT
Docket No.: 16591-105 (formerly f295100)

Examiner: A. Wachtel
Group Art Unit: 1771

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I CERTIFY THAT THIS PAPER IS BEING DEPOSITED WITH THE U.S. POSTAL SERVICE AS FIRST CLASS MAIL WITH SUFFICIENT POSTAGE AND IS ADDRESSED TO MAIL STOP APPEAL BRIEF-PATENTS, COMMISSIONER FOR PATENTS, P O BOX 1450, ALEXANDRIA, VA 22313-1450, ON SEPTEMBER 11, 2003 (37 CFR 1.8a). *Alan Kamrath*

APPEAL

Dear Sir:

This is an Appeal from the rejection of the Office communication mailed October 4, 2002 in the above-identified application.

The claims on appeal are appended hereto.

The Commissioner is authorized to charge \$320.00 and any deficiency or credit any over-payment to Deposit Account 501188.

Appellants hereby waives an oral hearing.

As requested by the Office, and for the convenience of the Board, Appellants' Brief is presented in triplicate.

Respectfully submitted,

Stephen Robert Carkeek

By: *Alan Kamrath*

Alan D. Kamrath (Reg. No. 28,227)
RIDER BENNETT, LLP.
333 South Seventh Street, Suite 2000
Minneapolis, MN 55402
Tel: (612) 340-8925
Fax: (612) 340-7900

Dated: September 11, 2003

RECEIVED
SEP 22 2003
TC 1700



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stephen Robert Carkeek
Serial No.: 09/486,629
Filed : March 1, 2000
For : TABLE OR COUNTER MAT
Docket No.: 16591-105 (formerly f295100)

Confirmation No. 8920
Examiner: A. Wachtel
Group Art Unit: 1771

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

In response to the Office Action mailed October 4, 2002, applicant wishes to appeal the rejections of Examiner Wachtel.

(1) **REAL PARTY IN INTEREST**

The present application has been assigned to Jayfield Pty Ltd. Rights have been granted to Kleentex USA.

(2) **RELATED APPEALS AND INTERFERENCES**

The present application is a national phase of a PCT application, PCT/AU99/00751.

(3) **STATUS OF CLAIMS**

Claims 1-4, 8, 12 and 47 are rejected under 35 USC §102(a). Claims 9 and 10 are rejected under 35 USC §102(a) as anticipated by, or in the alternative, under 35 USC §103(a). Claims 14 and 15 are rejected under 35 USC §102(a) as anticipated by, or in the alternative,

09/17/2003 AMENDR 1 00000093 501188
09486629
320.00 DA
01 FC:1402

under 35 USC §103(a). Claim 11 is rejected under 35 USC §103(a). Claims 13, 28-37, 41-44, 48 and 49 are rejected under 35 USC §103(a). Claims 7, 16, 17, 18, 19, 20 are rejected under 35 USC §103(a). Claims 21-27 are rejected under 35 USC §103(a).

(4) STATUS OF AMENDMENTS

A personal interview was held on May 23, 2002, which interview did reach an agreement. Claims 1, 4, 5, 7, 8, 11, 12, 13, 16 and 18 of originally filed claims 1-19 were amended in an Amendment mailed on May 29, 2002. Claims 1, 5, 7, 12 and 15-19 were amended and claims 20-49 were added in an Amendment filed by facsimile on September 20, 2002. An Amendment After Final has been filed concurrently herewith to overcome the rejection under 35 USC §112, first paragraph, of claims 21-27 and the rejection under 35 USC §112, second paragraph, of claim 48 and the claims attached hereto include the amended claims 21, 23, 25, 26 and 48.

(5) SUMMARY OF THE INVENTION

A table or counter mat having an composite sheet structure includes a non-slip backing layer (3); a top liquid absorbent textile surface (1) for resting cups, mugs or glasses; and an intermediate stabilization layer (2) joining the backing layer (3) to the textile surface (1) wherein the resultant mat is absorbent and really able to be laundered. The invention also provides a method for forming the table or counter mat by curing and bonding of the nitrile rubber backing layer (3) to the intermediate layer (2) and upper polyester textile layer (1) that greater than 100 degrees C. and preferably greater than 170 degrees C. Sublimation printing on the textile layer (1) occurs at greater than 100 degrees C. and preferably greater than 170 degrees C. such that the mat is able to be laundered in hot water. The rubber mat, backing layer (3), can be between 1 and 2 mm thick. The intermediate stabilization and pile support layer comprises a heat curable

material curable at temperatures greater than a 100 degrees C and preferably at about 170 degrees C such that the mat is able to be laundered hot water.

(6) ISSUES

Are claims 1-6, 8, 12 and 47 patentable under 35 USC §102(a) as being anticipated by US Patent No. 5,725,705 to Nagahama et al.? Are claims 9 and 10 patentable under 35 USC §102(a) as anticipated by, or in the alternative, under 35 USC §103(a) as obvious over US Patent No. 5,725,705 to Nagahama et al. in view of *Introductory Textile Science 5th Edition* by Marjory L. Joseph? Are claims 14, 15 allowable under 35 USC §102(a) as anticipated by or, in the alternative, patentable under 35 USC §103(a) as obvious over US Patent No. 5,725,705 to Nagahama et al. in view of *Introductory Textile Science 5th Edition* by Marjory L. Joseph? Is Claim 11 patentable under 35 USC §103(a) as being patentable over US Patent No. 5,725,705 to Nagahama et al. in view of US Patent No. 4,242,394 to Leib et al.? Are claims 13, 28-37, 41-44, 48 and 49 patentable under 35 USC §103 as being unpatentable over US Patent No. 5,725,705 to Nagahama et al. in view of US Patent No. 5,605,108 to Woosley? Is claim 46 patentable over 35 USC §103 as being unpatentable over US Patent No. 5,725,705 to Nagahama et al. in view of US Patent No. 5,605,108 to Woosley and US Patent No. 4,242,394 to Leib et al.? Are claims 7, 16, 17, 18, 19, 20 patentable under 35 USC §103 as being unpatentable over US Patent No. 5,725,705 to Nagahama et al. in view of US Patent No. 5,605,108 to Woosley and US Patent No. 4,609,580 to Rockett et al.? Are claims 21-27 patentable over 35 USC §103 as being unpatentable over US Patent No. 5, 725,705 to Nagahama et al. in view of US Patent No. 5,605,108 to Woosley and US Patent No. 4,408,567 to Reuben et al.?

(7) GROUPING OF CLAIMS

- (a) Claims 38-40;

- (b) Claims 1-6;
- (c) Claim 28;
- (d) Claims 29, 30, 42 and 43;
- (e) Claims 31 and 37;
- (f) Claims 32-35, 39, 41, 44, 45 and 46;
- (g) Claims 7-12, 16 and 17;
- (h) Claim 13;
- (i) Claims 14, 15 and 18-26;
- (j) Claim 36.

(8) ARGUMENT

- (a) Claims 38-40

Claims 38-40 were not rejected. Thus, it is respectfully requested that an indication of allowability be given.

- (b) Claims 1-6

Nagahama et al. shows a dust control mat that is laid in porches and entrances of shops, hotels, hospitals, offices and houses and that includes a base (1) formed by bonding a flossy nonwoven fiber web (6) to a woven or non woven fabric sheet (5) by needle punching or spot adhering. Piles (2) are implanted onto one surface of the base (1) by tuffeting the web (6) of the base (1). The base (1) is heat treated so as to melt or soften the low melting fibers in the flossy nonwoven fiber web (6) and to fix the piles (2) on the base (1). An elastomer backing (4) is formed on the nonpile surface of the base (1). Thus, Nagahama et al. shows only two elements, the base (1) and the elastomer backing (4). The piles (2) (which are part of base (1)) work to absorb and hold dust and dirt adhered to the bottoms of shoes.

Claim 1 requires three elements: a non-slipping layer; a top liquid absorbent textile surface; and an intermediate stabilization and pile support layer. It is respectfully submitted Nagahama et al. only teaches two of these elements. It is respectfully submitted that the floss-like nonwoven layer 6 of Nagahama et al. cannot be considered to be a top textile surface recited in claim 1 as woven or nonwoven fabric sheet 5 is necessary for structural and operational support of layer 6 and to create base 1, which is one of the two elements of the mat of Nagahama et al.

Further even assuming that Nagahama et al. somehow meets each of the three elements of claim 1, it is respectfully submitted that base (1) of Nagahama is not liquid absorbent. Although specifically teaching that the piles (2) absorb and hold dust and dirt, it is silent on its ability to absorb liquid. Recognizing this silence, the Examiner indicates that Nagahama et al. "would inherently have absorbance properties." However, the court in Ex parte Levy, 17 U.S.P.Q. 2d 1461 (Bd. Pat. App. & Inter. 1990) (emphasis in original) states:

In relying upon the theory of inherency, the examiner must provide as basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art.

Examiner Wachtel does not show that this inherent characteristic necessarily flows from Nagahama et al. In this regard, it is respectfully submitted that absorbing liquid would be undesired in Nagahama et al. as such liquid would turn dust and dirt absorbed and held by the floor mat into mud which would clearly stick on shoes engaging the mat and track on the floor, clearly against the intent of Nagahama et al.

Lastly, the Examiner contends that the mat of Nagahama et al. "would inherently have . . . the capacity to operate with a load force applied to its surface." Applicants agree that the mat of

Nagahama et al. was intended to be stepped upon and could accept the load force of cups, mugs, or glasses, but is clearly not intended or desired to rest cups, mugs or glasses thereon as is intended or desired for table or counter mats as in the present invention. The applicant has claimed a top liquid absorbent textile surface and an intermediate layer to form a counter mat, the absence of these limitations in Nagahama et al., Nagahama et al., being directed to two layer dust control mats, leads only to the conclusion that the invention is not shown and is not known to Nagahama et al.

It is then respectfully submitted that the 35 USC §102 rejection of claims 1-6 has been overcome.

(c) Claim 28

Claim 28 is believed to overcome the prior art rejection for the same and similar reasons as set forth for claims 1-6.

The Examiner recognizes that Nagahama et al. fails to teach the recited pile density and relies upon Woosley. Woosley relates to a motor vehicle carpet including selected high density area having greater resistance to wear and remaining areas have selected lower density areas having lesser resistance to wear while the entire module maintains substantially a uniform appearance. Pile tufts 14 extend from $\frac{1}{4}$ inch (.635 cm) and $1 \frac{1}{4}$ inch (3.175 cm).

The Examiner contends that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used Woosely's pile density, motivated by the desire to save material and production costs while maintaining product performance".

It is respectfully submitted the Woosley utilizes the lesser density areas to save material and production costs rather than have the entire vehicle carpet formed from higher density areas. There is nothing in Nagahama et al. which would indicate that its expressly taught mat to have

areas which require greater resistance to wear. Thus, to save material and production costs, a person skilled in the art would use the lower density disclosed in Nagahama et al. and would not use the higher density taught in Woosley. Further, Woosley is similarly deficient in failing to teach the recited density is for support of cups, mugs or glasses, to absorb any spilled liquids from the cups, mugs, or glasses and/or to provide a message communication. Thus, it is respectfully submitted that the Examiner has simply located Woosley as having a top layer of the desired density, but has failed to consider why a person skilled in the art would utilize and/or combine the teachings of Nagahama et al. and Woosley, except to meet the recitations of the claims.

Particularly, Examiner Wachtel has identified structures in the prior art with regard to individual elements recited in the claim that are conventional. However, even assuming that all of the features claimed are old or conventional or within the knowledge of one of ordinary skill in the art does not mean that the combination of the feature is obvious. Specifically, the CAFC in Environmental Designs, Ltd. v. Union Oil Co. of Cal., 218 U.S.P.Q. 865, 870 (1983) stated:

All the pieces of the present invention were known in the art, . . . That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art. (Case citations).

Furthermore, the CAFC in American Hoist & Derrick Co. v. Sowa & Sons, Inc., 220 U.S.P.Q. 763, 771 (1984) quoted:

A patentable invention * * * may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis theirs).

These decisions recognize that invention can result from the selection of old features. As stated by Judge Hand in B.G. Corp v. Walter Kidde Co., 79 F.2d 20, 22, 26 U.S.P.Q. 288, 289-290 (2nd Cir. 1935).

All machines are made up of the same elements; rods, pawls, pitmans, journals, toggles, gears, cams, and the like, all acting their part as they always do and always must. * * * But the elements are capable of an infinity of permutations and the selection of that group which proves serviceable to a given need may require high degree of originality. It is that act of selection which is the invention * * *.

Specifically, the CAFC in Ecolochem Inc. v. Southern California Edison Co., 227 F.3d 1361, 56 U.S.P.Q.2d 1065 (2000) stated:

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See Dembiczak, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.” Id.

“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” In re Rouffet, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987)). The same principle applies to invalidation. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Although the suggestion to combine references may flow from the nature of the problem, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 U.S.P.Q.2d 1626, 1630 (Fed. Cir. 1996), “[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness,” Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 880, 45 U.S.P.Q.2d 1977, 1981 (Fed. Cir. 1998). Therefore, “[w]hen determining the patentability of a claimed invention which combines two known elements, ‘the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.’” In re Beattie, 974 F.2d 1309, 1311-12, 24 U.S.P.Q.2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann, 730 F.2d at 1462, 221 U.S.P.Q. at 488).

In this case, the district court used the '411 patent as a blueprint, with the Houghton process as the main structural diagram, and looked to other prior art for the elements present in the patent but missing from the Houghton process. The district court opinion does not discuss any specific evidence of motivation to combine, but only makes conclusory statements. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" Dembiczak, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617.

* * *

The absence of a convincing discussion of the specific sources of the motivation to combine the prior art references, particularly in light of the strength of prior art teaching away from the use of the Houghton process, is a critical omission in the district court's obviousness analysis, which mainly discusses the ways that the multiple prior art references can be combined to read on the claimed invention.

* * *

Because we do not discern any evidentiary basis for the finding by the district court that there was a suggestion, teaching, or motivation to combine the prior art references cited against the claimed invention, the district court's conclusion of obviousness cannot stand. The implicit generalized finding by the district court that, when one of ordinary skill in the art was faced with the problem of deoxygenating water for use in a nuclear power plant and the Houghton article, the combination claimed by Ecolochem in the '411 patent would have been obvious is insufficient. We have previously held that "[t]he suggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 U.S.P.Q.2d 1385, 1397 (Fed. Cir. 1999). However, there still must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1456; see also In re Werner Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000) ("[A] rejection cannot be predicated on the mere identification . . . of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."). Here, there was no such evidence presented.

Turning to the present application, Nagahama et al. provides no source of a motivation to modify its structure or to combine with the structures of Woosley. Furthermore, even assuming

that one would combine the structures of Nagahama and Woosley, the Examiner is selecting only the density of Woosley while excluding the pile length expressly taught by Woosley for its mat.

As stated by the CCPA in In re Kamm and Young, 172 U.S.P.Q. 298 at 301 and 302:

The rejection here runs afoul of a basis mandate inherent in Section 103--that "a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure" shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870, 26 F.2d 393, 396, 125 U.S.P.Q. 328, 331 (1960). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (1965). We think this has been done here.

We appreciate the relative ease with which one can slip into such an error, especially where, as here, the primary reference addresses the same problem as appellants and solves it using merely a different chemical agent. However, we are satisfied that when the secondary references are viewed in their entirety, with due consideration given to what they fail to disclose and what they disclose as undesirable, it is evident that the proposed modification of the primary reference would not have been obvious to one of ordinary skill in the art at the time the invention was made.

It is then respectfully submitted that the rejection of claim 28 under 35 USC §103 has been overcome for these separate and independent reasons.

(d) Claims 29, 30, 42 and 43

Claims 29, 30, 42 and 43 are believed to overcome the prior art rejections for the same and similar reasons as set forth for claim 28.

Additionally, there is absolutely no suggestion in either reference as admitted by the Examiner to teach the recited thickness ratios. The Examiner then asserts routine experimentation. However, as stated in Ex parte Argabright and Hall 161 USPQ 704.

The obviousness of the claimed process must be predicted on something more than the possibility that the prior art in time will consider a particular course of action because it has been neglected in the past.

The purported motivation to optimize the claimed parameters resembles the motivation of Nagahama et al. and not the claimed invention. The claimed invention is directed toward a table or counter mat that has divergent requirements. Therefore, it would not have been obvious to experiment to modify a floor mat to perform a function not taught as desired in the prior art.

Thus, it is then respectfully submitted that the rejection of claims 29, 30, 42 and 43 under 35 USC §103 first paragraph has been overcome for these separate and independent reasons.

(e) Claims 31 and 37

For the same and similar reasons set forth for the allowability of claim 28, claims 31 and 37 are allowable.

Additionally, Woosley expressly teaches a pile height between $\frac{1}{4}$ inch and $1 \frac{1}{4}$ inch. The Examiner is picking the density expressly taught by Woosley while ignoring the pile height expressly taught by Woosley. This is not a proper basis for rejecting the claims based upon the case decisions set forth for claim 28.

It is respectfully submitted that the rejection of claims 31 and 37 under 35 USC §103(a) has been overcome for these separate and independent reasons.

(f) Claims 32-35, 39, 41, 44, 45 and 46

For same and similar reasons as set forth for claim 28, the structure and function of claims 32-35, 39, 41, 44, 45 and 46 are not found in the art.

Additionally, there is no teaching and, as admitted by the Examiner, the art fails to teach the recited thickness of the rubber layer, but indicates experimentation could arrive at this deficiency in the prior art. However, as set forth in Ex parte Argabright, it would not have been obvious to perform experiments directed toward the limitations of claims 32-35, 39, 41, 44, 45 and 46 because the art provides no such limitations and no motivation for such limitations.

Without the benefit of the applicant's disclosure one skilled in the art wouldn't even know what to experiment with or how to experiment because the art is directed toward floor mats that do not have the same intended use as the table or counter mat of the present invention.

It is respectfully submitted that the rejection of claims 32-35, 39, 41, 44, 45 and 46 under 35 USC §103(a) has been overcome for these separate and independent reasons.

(g) Claims 7-12, 16 and 17

Claims 7-12, 16 and 17 are believed to overcome the rejections for the same and similar reasons as set forth for Claims 1 – 6 and Claim 28.

Additionally, Rockett discloses an absorbent floor mat including a wear surface, an intermediate absorbent microfiber layer, and a liquid impervious surface. The wear surface is formed of a chemically, overall bonded continuous filament web of a basis weight of 15 to 200 grams per square meter. Rockett is silent as to thickness, liquid absorbency and the existence of an/or height of piles of the wear surface. In this regard, it is respectfully submitted that Rockett would rather have the liquid be absorbed in the intermediate layer and not the wear layer, with the wear layer being the sole element of Rockett that the Examiner is relying upon.

As layer 6 of Nagahama et al. is disclosed as a "floss-like nonwoven layer" consisting of "high molecular thermoplastic polyester", it is unsure what Rockett is being utilized to replace in Nagahama et al. alone or in combination with Woosley. However, if the wear surface of Rockett were for some reason contend utilized as the top surface of the modified mat, there is no teaching or suggestion that such wear layer would be liquid absorbent. Further, why would a person skilled in the art select just the wear surface of Rockett while ignoring the intermediate absorbent microfiber layer and liquid imperious surface also taught.

It appears that the Examiner is relying upon tufts 2 of Lieb to replace the mat piles 2 of Nagahama et al.. However, assuming for the sake of argument that it is desirable and possible to do so, the resulting base fabric 1 of Nagahama et al. with tufts 2 of Lieb is deficient for the same and similar reasons as is Nagahama et al. alone. Thus, it is respectfully submitted that the mats of Nagahama et al. alone or in combination with Lieb does not arrive at the recited invention.

Thus, it is respectfully submitted that the 35 USC §103 rejection of claims 7-12, 16 and 17 has been overcome for these separate and independent reasons.

(h) Claim 13

Claim 13 is believed to overcome the prior art rejection for the same and similar reasons as set forth for claims 7-12, 16 and 17.

Additionally, claim 13 is believed to overcome the prior art rejection for the same and similar reasons as set forth for claim 28.

Thus, it is respectfully submitted that the 35 USC §103 rejection of claim 13 has been overcome for these separate and independent reasons.

(i) Claims 14, 15 and 18-26

Claims 14, 15 and 18-26 are believed to overcome the prior art rejection for the same and similar reasons as set forth for claims 7-13, 16 and 17.

Joseph is a textbook generally relating to printing methods. It is not contended that the applicant invented such printing processes. However, such printing processes have generally not been applied to mats. It is respectfully submitted that the reasons for this is that generally prior mats did not provide a top surface which was continuous and consistent so that the textile surface layer substantially maintains relative position for receiving and displaying a detailed image as recited in claims 15, 19, 20 and 23.

It appears that the Examiner concedes that Nagahama et al. does not meet the recitations of the claims, but dismisses this as the recitations are not given patentable weight and as being obvious in view of Joseph.

However, the claim language can not be ignored following the teachings of In re Land and Rogers, 151 U.S.P.Q. 621, 635 (CCPA 1966) which stated:

The dependent claims contain further limitations which the board regarded as functional and gave no weight to them. Since claim 71 depends from 70 they have a common limitation in 70 which is, we think, significant. It reads:

* * * said color-providing substances associated with at least the inner photo-sensitive emulsion layers are *adapted to be rendered diffusible* in said liquid composition *only after at least substantial development* of the next outermost photosensitive * * * layer has occurred. [Emphasis theirs.]

It is true that the italicized portions are "functional" but we do not regard that as good ground to give them "no weight" in view of the third paragraph of 35 U.S.C. 112. We give them weight and with this limitation we think claims 70 and 71 are limited to deferred diffusion *built into the structure recited*, thereby being limited to the actual invention disclosed and hence allowable . . . [Emphasis theirs].

See also MPEP §2173.05(g). It is respectfully submitted that claims 13, 14 and 18-26 are directed to a specific limitation as claimed and the limitations cannot be ignored.

Additionally, there is nothing in Nagahama et al. that would lead a person skilled in the art that it is desirable or possible to utilize the printing methods of Joseph in its mat and Joseph provides no suggestion that its printing methods could be utilized on mats. Thus, it is respectfully submitted that the claim recitations are not obvious. Additionally, even if somehow combined, the resulting combination does not meet the specific construction of the top textile surface also recited and which is believed to produce a detailed image which is clearly not suggested by the prior art.

Thus, it is respectfully submitted that the rejection of claims 14, 15 and 18-26 has been overcome for these separate and independent reasons.

(j) Claim 36

For the same and similar reasons set forth with regard to claim 35 and the following reasons, claim 36 is allowable.

Additionally, since Nagahama et al. does not have an intermediate stabilization member, the limitations of claim 36 cannot be obvious in view of the cited references and in view of the inherent properties of the polyester. It is therefore not reasonable to presume that said limitations would be met by the combination of the two references with regard to experimentation because they are not combinations found in the prior art. Furthermore, as stated in Ex parte Argabright, there is no suggested teaching in the prior references to conduct a stability experiment directed toward the claim limitations without the teachings, guidance and the benefit of applicant's disclosure.

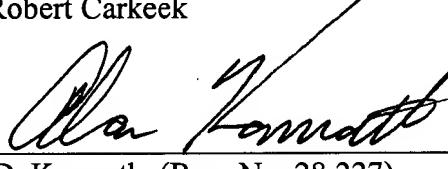
Thus, it is then respectfully submitted that the rejection of claim 36 under 35 USC §103(a) has been overcome for these separate and independent reasons.

(9) CONCLUSION

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicant's table or counter mat having a composite sheet structure which were neither shown, described, taught nor eluded to in any of their references cited by the Examiner and by the applicant, whether those references are taken singly or in any combination, the Board of Appeals is requested to reverse the rejections of the Examiner, allow claims 1-26, 28-49 and to pass the application to issue.

Respectfully submitted,

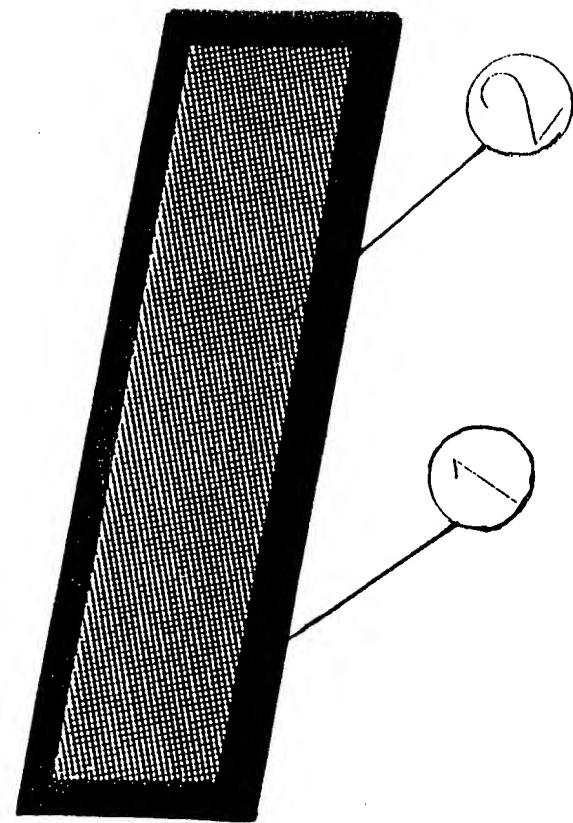
Stephen Robert Carkeek

Dated: September 11, 2003
By: 
Alan D. Kamrath (Reg. No. 28,227)
RIDER BENNETT, LLP.
333 South Seventh Street, Suite 2000
Minneapolis, MN 55402
Tel: (612) 340-8925
Fax: (612) 340-7900

THIS PAGE BLANK (USPTO)

1/2

FIG. 1



2/2

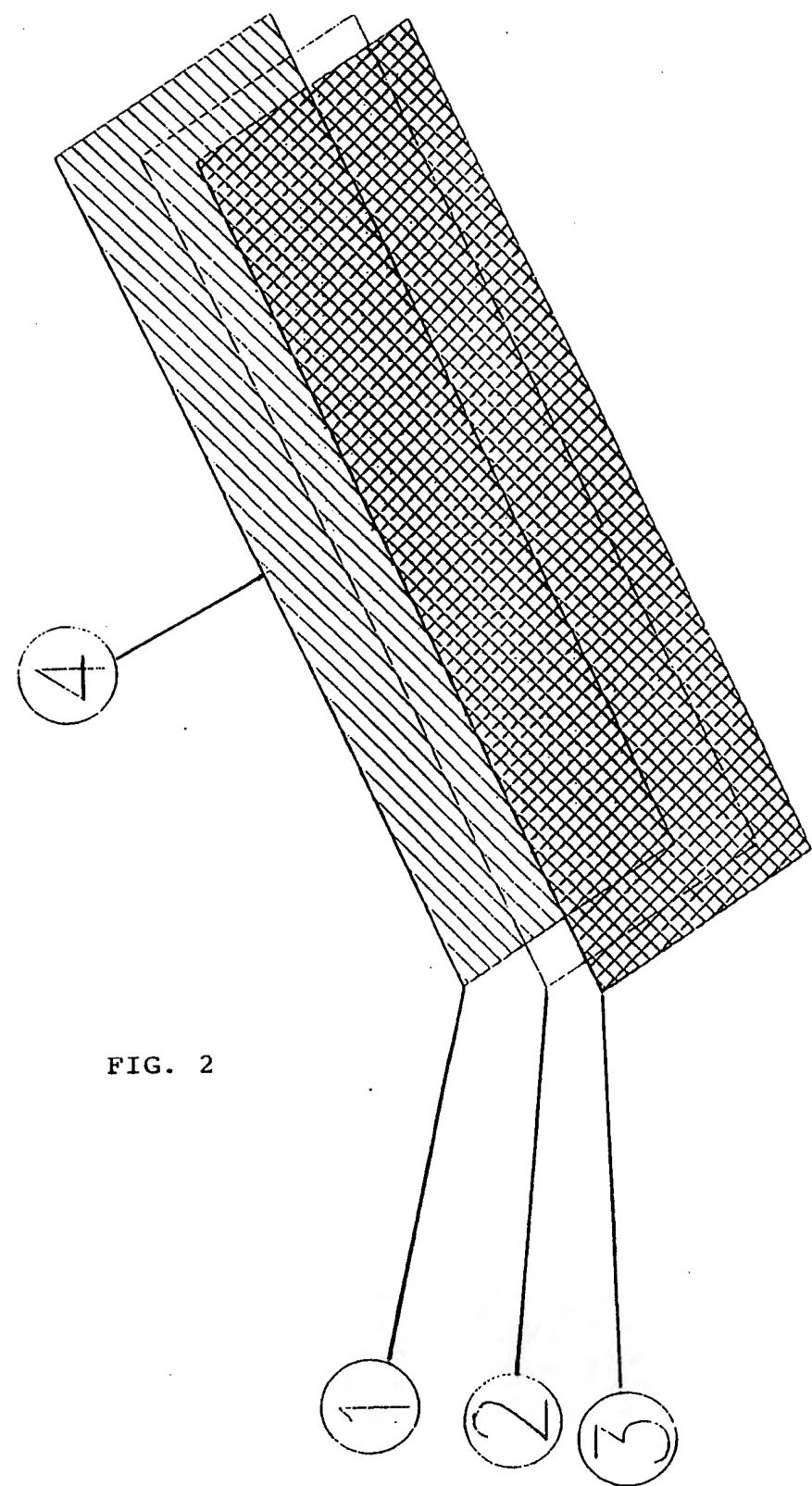


FIG. 2

THIS PAGE BLANK (USPTO)

CLAIMS

Claim 1 (previously amended) A table or counter mat having a composite sheet structure comprising:

- a non-slip backing layer;
- a top liquid absorbent textile surface; and

an intermediate stabilization and pile support layer joining the backing layer to the textile surface and aiding support of the textile surface, with the textile surface having a pile height less than 7 millimeters adapted for resting cups, mugs or glasses and for retaining an element of absorbency, wherein the resultant mat is readily able to be laundered.

Claim 2 (original) A table or counter mat according to claim 1 wherein the non-slip backing layer is formed from rubber.

Claim 3 (original) A table or counter mat according to claim 2 wherein the non-slip backing layer is formed from a nitrile rubber.

Claim 4 (previously amended) A table or counter mat according to claim 3 wherein the nitrile rubber is in the range of less than 2 mm thick with a density of about 1000 grams per square meter.

Claim 5 (previously amended) A table or counter mat according to claim 3 wherein the intermediate stabilization and pile support layer comprises a heat curable material curable at temperatures greater than 100°C and preferably at about 170°C such that the mat is able to be laundered in hot water.

Claim 6 (original) A table or counter mat according to claim 5 wherein the intermediate layer is formed from a non-woven polyester.

Claim 7 (previously amended) A table or counter mat having a composite sheet structure comprising:

- a top textile surface layer;
- a non-slip backing layer;

and an intermediate stabilization and support layer aiding joining and support of the top textile surface layer to the non-slip backing layer while allowing the top textile surface layer of the resultant mat to be absorbent;

the non-slip backing layer is formed from a nitrile rubber curable at temperatures greater than 100°C and preferably at about 170°C such that the mat is able to be laundered in hot water;

the intermediate stabilization and support layer is formed from a non-woven polyester, and

the top textile surface layer is a non-woven polyester with a pile height substantially in the range of 3 to 7 millimeters, with the intermediate stabilization and support layer and the top textile surface layer combined with the non-slip backing layer forming a top liquid absorbent textile of less than 4 millimeters which is continuous and consistent and maintains relative position for printing a detailed image thereon and maintaining position to display the detailed image.

Claim 8 (previously amended) A table or counter mat according to claim 5 wherein the textile surface includes a textile marking providing a coloring, a print or an advertising message viewable from above.

Claim 9 (previously amended) A table or counter mat according to claim 8 wherein the textile marking is formed by a sublimation textile printing process.

Claim 10 (previously amended) A table or counter mat according to claim 9 wherein the sublimation printing occurs at greater than 100°C and preferably greater than 170°C such that the mat is able to be laundered in hot water.

Claim 11 (previously amended) A table or counter mat according to claim 10 wherein the top liquid absorbent textile surface is formed from a polyester surface with a pile height substantially in the range of 3 to 7 millimeters.

Claim 12 (previously amended) A table or counter mat according to claim 8 wherein the top liquid absorbent textile surface is formed from a tufted nylon cut pile surface.

Claim 13 (previously amended) A table or counter mat according to claim 12 wherein the textile surface has a density of about 600 grams per square meter.

Claim 14 (previously amended) A table or counter mat according to claim 13 wherein the textile marking is formed by an acid dye process.

Claim 15 (previously amended) A table or counter mat readily able to be laundered having a composite sheet structure comprising:

a nitrile rubber non-slip backing layer aiding the mat to lie flat;

a top liquid absorbent polyester textile surface layer having a surface height less than 7 millimeters and preferably less than 2 millimeters to allow resting thereon of cups or glasses or the like and having a density of pile sufficient to form an absorbent layer; and

wherein the textile surface layer is continuous and consistent so that the textile surface layer substantially maintains relative position for receiving and displaying a detailed image by a textile printing providing a print or advertising message viewable from above.

Claim 16 (previously amended) A method of forming a table or counter mat including:

- a) forming a nitrile rubber sheet material as a backing layer;
- b) forming a top textile surface layer by combining a non-woven polyester fabric with a non-woven polyester stabilization and pile support fabric; and
- c) aligning the top and backing layers and compressing the layered materials by a heated platen for selected time duration, pressure and temperature settings to cure and bond the nitrile rubber backing layer to the top textile surface layer;

wherein the resultant table or counter mat lays flat and is able to support stably a glass or other similar liquid vessel with the table or counter mat being liquid absorbent to absorb any spilled liquid.

Claim 17 (previously amended) A method of forming a table or counter mat according to claim 16 wherein the curing and bonding of the nitrile rubber backing layer to the top textile surface layer occurs at greater than 100°C and preferably greater than 170°C such that the mat is able to be laundered in hot water.

Claim 18 (previously amended) A method of forming a table or counter mat according to claim 16 further including:

providing a sublimation printing process by placing a screen printed or digital image printed paper which carries the required design on the top textile surface layer with print face down and activating a heat platen to press the screen printed or digital image printed paper to the top textile surface layer under a selected heat, pressure and time duration.

Claim 19 (previously amended) A method of forming a table or counter mat including:

- a) forming a nitrile rubber sheet material as a backing layer;
- b) forming a top textile surface layer which is non-tufted and is continuous and has a density and a pile height substantially in the range of 3 to 7 millimeters able to be printed thereon by sublimation printing;
- c) aligning the top and backing layers;
- d) compressing the aligned materials by a heated platen for a selected time duration, pressure and temperature settings to cure and bond the nitrile rubber backing to the top textile

layer so that the resultant table or counter mat lays flat and is able to support stably a glass or other similar liquid vessel and the table or counter mat is liquid absorbent to absorb any spilled liquid;

wherein the curing and bonding of the nitrile rubber backing to the top textile surface layer occurs at greater than 100°C and preferably greater than 170°C such that the mat is able to be laundered in hot water;

e) placing a screen printed, offset or digital image print paper which carries a detailed image on the top textile layer surface of the bonded resultant table or counter mat with print face down; and

f) activating a heat platen to press the screen printed, offset or digital image print paper to the top textile surface layer under selected heat, pressure and time duration and at greater than 100°C and preferably greater than 170°C such that the mat is able to be laundered in hot water, with the top supported textile surface layer bonded with the backing layer forming a top liquid absorbent textile of less than 4 millimeters which is continuous and consistent and maintains relative position for printing the detailed image thereon and maintaining position to display the detailed image.

Claim 20 (previously presented) A method of forming a table or counter mat according to claim 19 with the top textile surface layer formed by a non-woven non tufted polyester and an intermediate layer of a non-woven polyester.

Claim 21 (previously amended) A table or counter mat having a composite sheet structure comprising:

a top textile surface layer;

a non-slip backing layer;

and an intermediate stabilization and support layer aiding joining and support of the top textile surface layer to the non-slip backing layer while allowing the top textile surface layer of the resultant mat to be absorbent;

the non-slip backing layer is formed from a nitrile rubber in the range of less than 2 mm thick with a density of about 1000 -1200 grams per square meter and curable at temperatures greater than 100°C such that the mat is able to be laundered in hot water;

the intermediate stabilization and support layer and the top textile surface layer are a polyester surface which when the intermediate stabilization and support layer and the top textile

surface layer are combined with the non-slip backing layer forms a top liquid absorbent textile of less than 4 millimeters which is continuous and consistent and maintains relative position for printing a detailed image thereon and maintaining position to display the detailed image.

Claim 22 (previously presented) The mat according to claim 21 with the non-slip backing layer being curable at temperatures greater than 170°C.

Claim 23 (previously amended) A table or counter mat having a composite sheet structure comprising:

a top fabric layer;

a non-slip backing layer;

a part of the top fabric layer able to be joined to the non-slip backing layer while allowing the top fabric layer of the resultant mat to be absorbent;

the non-slip backing layer is formed from a nitrile rubber in the range of less than 2 mm thick with a density of about 1000 -1200 grams per square meter and curable at temperatures greater than 100°C such that the mat is able to be laundered in hot water;

the top fabric layer being a polyester surface which when combined with the non-slip backing layer forms a top liquid absorbent textile of less than 4 millimeters which is continuous and consistent and maintains relative position for printing a detailed image thereon and maintaining position to display the detailed image.

Claim 24 (previously presented) The mat according to claim 23 with the non-slip backing layer being curable at temperatures greater than 170°C.

Claim 25 (previously amended) The mat according to claim 24, wherein the top fabric layer includes a polyester surface.

Claim 26 (previously amended) The mat according to claim 24, wherein the top fabric layer includes a polyester surface.

Claim 27 (canceled)

Claim 28 (previously presented) A table or counter mat comprising, in combination: a non-slip backing layer; and a top liquid absorbent polyester textile layer joined to the non-slip backing layer to form a composite sheet structure which is readily able to be laundered, with the top liquid absorbent textile layer having a density of about 200 to 600 grams per square meter to stably support cups, mugs or glasses, to absorb any spilled liquid from the cups, mugs or glasses supported thereon, and to provide a message communication covering with clarity.

Claim 29 (previously presented) The table or counter mat according to claim 28 with the non-slip backing layer having a thickness, with the top liquid absorbent textile layer having a height, with a ratio of the height of the top liquid absorbent textile layer to the thickness of the non-slip backing layer being about 10 to 1.

Claim 30 (previously presented) The table or counter mat according to claim 29 with the thickness of the non-slip backing layer being less than about 2 mm.

Claim 31 (previously presented) The table or counter mat according to claim 30 with the top liquid absorbent textile layer being a tufted synthetic yarn cut pile surface with a pile height of about 6 mm and a pile weight of about 600-620 grams per square meter.

Claim 32 (previously presented) The table or counter mat according to claim 31 with the thickness of the non-slip backing layer being about 1 mm.

Claim 33 (previously presented) The table or counter mat according to claim 32 with the non-slip backing layer formed from rubber having a density of about 1000 grams per square meter.

Claim 34 (previously presented) The table or counter mat according to claim 33 further comprising, in combination: an intermediate stabilization layer joining the non-slip backing layer to the top liquid absorbent textile layer.

Claim 35 (previously presented) The table or counter mat according to claim 34 with the intermediate stabilization layer formed of synthetic thermally bonded non-woven fabric.

Claim 36 (previously presented) The table or counter mat according to claim 35 with the intermediate stabilization layer having a density of 110 grams per square meter and a tensile strength of 190 Newtons per 5 cm with a maximum elongation of plus 30% and a tear strength of 140 Newtons, with the intermediate stabilization layer formed of a material curable at temperatures greater than 100°C such that the composite sheet structure can be laundered in hot water.

Claim 37 (previously presented) The table or counter mat according to claim 28 with the top liquid absorbent textile layer being a tufted synthetic yarn cut pile surface with a pile height of about 6 mm and a pile weight of about 600-620 grams per square meter.

Claim 38 (previously presented) The table or counter mat according to claim 30 with the top liquid absorbent textile layer being a synthetic, scrim supported, fiber needlefelt having a density of about 500 grams per square meter.

Claim 39 (previously presented) The table or counter mat according to claim 38 with the thickness of the non-slip backing layer being about 1 mm.

Claim 40 (previously presented) The table or counter mat according to claim 39 with the non-slip backing layer having a density of 1000 grams per square meter.

Claim 41 (previously presented) The table or counter mat according to claim 28 with the thickness of the non-slip backing layer being about 1 mm.

Claim 42 (previously presented) A table or counter mat comprising, in combination: a non-slip backing layer; and a top liquid absorbent textile layer joined to the non-slip backing layer to form a composite sheet structure, with the top layer absorbent textile layer having a height, with the non-slip backing layer having a thickness, with a ratio of the height of the top liquid absorbent textile layer to the thickness of the non-slip backing layer being about 1 to 1.

Claim 43 (previously presented) The table or counter mat according to claim 42 with the thickness of the non-slip backing layer being less than about 2 mm.

Claim 44 (previously presented) The table or counter mat according to claim 42 with the thickness of the non-slip backing layer being about 1 mm.

Claim 45 (previously presented) The table or counter mat according to claim 44 with the top liquid absorbent textile layer being a surface with a pile height of about 2 mm.

Claim 46 (previously presented) A table or counter mat according to claim 44 with the top liquid absorbent textile layer formed from a polyester surface with a pile height substantially in the range of 3 to 7 millimeters.

Claim 47 (previously presented) A table or counter mat comprising, in combination: a non-slip backing layer; and a top layer joined to the non-slip backing layer to form a composite sheet for resting cups, mugs or glasses on the top layer, with the top layer consisting of synthetic textile surface of a high density capable of stably supporting such cups, mugs or glasses resting on the top layer and being liquid absorbent to absorb any liquid spilled from such cups, mugs or glasses resting on the top layer.

Claim 48 (previously amended) The table or counter mat according to claim 47 with the high density of the synthetic textile surface being about 200 to 600 grams per square meter.

Claim 49 (previously presented) The table or counter mat according to claim 47 with the thickness of the non-slip backing layer being less than about 2 mm.